

REMARKS

In view of the following remarks, the Examiner is requested to allow claims 1-13, 17-19, 34, 49, 50, 56, 57 and 59-65, as well as newly added Claims 66-70, the only claims pending and under examination in this application.

Claim 1 has been amended to further define the sub-array element. Support for this amendment is found on page 9, lines 4, 12. In addition, this section of the specification also supports new claims 66-70. As no new matter has been added by way of this amendment, entry thereof by the Office is respectfully requested.

Claim Rejections - 35 U.S.C. § 102

Claims 1-13, 46, 50, 56, 57, 59-63 and 65 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Stern (US 2002/0055102).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

An element of the claims at issue is:

"receiving a request for a test which uses a sub-array of a chemical array with probes at multiple feature locations..."

A "sub-array" is not a second array that is separate from a first array, but a collection of less than all of the features that is found in the first array, such that sub-array comprises less than all of the multiple feature locations of the first array.

In asserting that the Stern teaches this element of the claimed invention, the Office points to paragraphs 98 and 99 of Stern. Paragraph 98 reads in part:

[0098] Graphical user interfaces (GUI's) 2782 may be presented to a user so that the user may select particular microarrays of array 2770, and their order, for scanning. For example, in accordance with any of a variety of conventional user-interface techniques, a user may be presented by GUI's 2782 (under the control of GUI controller 2715) with a list of microarrays included in array 2770 identified, for example, by a list of names or identifiers, and/or by a graphical representation of the microarrays in an array configuration on a monitor or other output device of input/output devices 2780. Thus, using the example given above in which array 2770 consists of 49 microarrays arranged in 7 rows and 7 columns, a graphic of 49 elements could be presented to the user. The user could select all 49 elements (using any of a variety of conventional user-interface selection techniques) if it were desired that each of the 49 microarrays were to be sequentially scanned. Alternatively, the user could select one or more of the 49 microarrays, in any designated order or combination, for sequential scanning. In yet another alternative implementation, a user could

As can be seen from the above excerpt, Stern is suggesting a method where a user employs a GUI to choose an array for a plurality of different arrays. However, nowhere in the cited passages from Stern is taught or suggested to select a sub-array of an array.

As such, Stern fails to teach each and every element of the claims since Stern fails to teach or suggest a method that employs a sub-array as claimed. Accordingly, 35 U.S.C. Claims 1-13, 34, 49, 50, 56, 57, 59-63 and 65 are not anticipated § 102(b) by Stern and this rejection may be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 6, 12, 13 and 17-19 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stern in view of Podyminogin et al., (Nucleic Acids Research (2001) 29(24):5090-5098). As set forth above, Stern is deficient because Stern fails to teach or suggest a method that employs a sub-array of an array. As Podyminogin was cited solely for its asserted disclosure that a "lack of binding may be caused by cross-linking or cleavage," it fails to remedy the deficiencies of Stern. Accordingly, this rejection may be withdrawn.

Claims 1, 34 and 64 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stern in view of Sandstrom (2005/0079603). As set forth above, Stern is deficient because Stern fails to teach or suggest a method that employs a sub-array of an array. As Sandstrom was cited solely for its asserted disclosure of masking a microarray, it fails to remedy the deficiencies of Stern. Accordingly, this rejection may be withdrawn.

Finally, newly presented Claims 66 to 70 are patentable over the cited references for at least the reasons provided above.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10021296-1.

Respectfully submitted,

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By: 

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